

## **II. REMARKS**

A Non-final Office Action was issued in this application on January 14, 2011 (hereinafter "Non-final Action"). In response to the Non-final Action, Applicant filed an Amendment under 37 C.F.R. § 1.111 on April 28, 2011; this Amendment is believed to have been fully responsive to the Non-final Action. Nevertheless, an Office Communication was mailed on July 18, 2011, which included a Notice of Non-compliant Amendment. This submission is believed to be fully responsive to both the Office Communication and the Non-final Action.

Since Applicant's previously filed Amendment was not entered for allegedly being non-compliant, claims 5, 7, 10, 16 and 38-41 remain pending in this application, and all pending claims remain rejected. Claims 5, 7, 10, 16 and 38-41 are amended herein, and new claims 42-49 have been added. After entering this submission, claims 5, 7, 10, 16 and 38-49 remain pending in this application. Reconsideration and allowance of this application in view of the above amendments, Applicant's previously submitted remarks, and the following comments is herein respectfully requested.

### **A. STATEMENT OF SUBSTANCE OF EXAMINER INTERVIEW**

On Wednesday, August 3, 2011, Applicant's attorney, Mark J. Levine (Reg. No. 60,300), conducted a telephonic interview of Examiner Jason Pinheiro, which was supervised by Supervisory Examiner Melba Bumgarner. There were no other participants present during the interview. In addition, there were no exhibits shown and no demonstrations were conducted during the telephonic interview. During the interview, the parties discussed the propriety of the Notice of Non-compliant Amendment. The Examiners suggested that the claims be rewritten to more clearly indicate how the amended claims are directed to an invention that is not independent and distinct from the claims as previously presented. Although Applicant maintains that the Notice is incomplete and was improperly issued, Applicant has amended the claims as suggested by the Examiners in an attempt to help expedite prosecution of the captioned application. Otherwise, no agreement was reached as to the allowability of the claims. This summary is intended solely to make the substance of the interview part of the record in compliance with 37 C.F.R. §§ 1.2 and 1.133(b). *See, e.g.*, MPEP 713.01, 713.04. Applicant and Applicant's attorney sincerely thank both Examiners for the courtesy of the interview.

**B. CLAIM REJECTIONS – 35 U.S.C. 103**

Claims 5, 10, 16 and 38 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,343,161 B2, to Uchida (hereinafter “Uchida”), in view of U.S. Patent No. 6,157,529, to Ahuja (hereinafter “Ahuja”), and U.S. Patent No. 7,374,258 B2, to Bowron (hereinafter “Bowron”). *See* Non-final Office Action, at 2, Item No. 2. In addition, claims 7 and 39-41 are rejected under 35 U.S.C. § 103(a) as being obvious over Uchida, in view of Ahuja and Bowron, and further in view of U.S. Patent No. 6,517,433 B2, to Loose et al. (hereinafter “Loose”). *See, id.*, at 3, Item No. 2. Applicant respectfully requests reconsideration and withdrawal of all pending § 103(a) rejections for at least those reasons set forth in Section II of Applicant’s Amendment under 37 C.F.R. § 1.111, which was submitted on April 28, 2011, at 9-12, which is incorporated herein by reference in its entirety.

**C. NOTICE OF NON-COMPLIANT AMENDMENT**

An Office Communication was mailed on July 18, 2011, which included a Notice of Non-compliant Amendment (hereinafter “Notice”). In the Notice, it is alleged that Applicant’s previously filed Amendment, which amended all of the pending claims, “now present[s] only claims drawn to a non-elected invention [and therefore] is non-responsive (MPEP § 821.03).” The sole basis for this allegation that is presented in the Notice is that “the currently presented claims have a different mode of operation”. Applicant respectfully submits that the Notice is improper and must be withdrawn for at least two reasons: first, there is insufficient evidence on the record to show that the previously amended claims are independent and distinct from the originally claimed invention; and, second, there is no evidence indicating that there would be a serious burden on the Examiner if restriction is not required.

**1. The Notice does not present sufficient evidence to show that the previously amended claims are independent or distinct from the previously pending claims.**

There are two basic criteria for a proper requirement for restriction and election: first, “[t]he inventions must be independent or distinct as claimed;” and second, “[t]here would be a serious burden on the examiner if restriction is not required.” MPEP 803(I). The burden is on the examiner, not the applicant, to establish the propriety of a requirement for restriction and election. *See, e.g.*, MPEP 803(II); 806.05(j). Pursuant to MPEP 808.01, “[t]he particular reasons

relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated.” More importantly, “[a] mere statement of conclusion is inadequate;” rather “[t]he reasons upon which the conclusion is based should be given.” *Id.*

For claimed inventions to be statutorily “independent,” the claims must be unrelated – i.e., “there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect.” MPEP 802.01(I). Independence can be substantiated with evidence that the inventions “[are] not disclosed as capable of use together, [have] different modes of operation, [have] different functions *and* [have] different effects”. MPEP 806.06. By contrast, two or more inventions “are related (i.e., not independent) if they are disclosed as connected in *at least one* of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect.” MPEP 802.01(II) (emphasis added).

“To support a requirement for restriction between two or more related [i.e., not independent] product inventions ... *both two-way distinctness and reasons for insisting on restriction are necessary.*” MPEP 806.05(j) (emphasis added). For claimed inventions to be statutorily “distinct,” the reviewing examiner must show *all* of the following:

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; *and*
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

MPEP 806.05(j) (original emphasis omitted; new emphasis added). There is insufficient evidence on the record to show that the previously presented amended claims are either “independent” or “distinct” from the originally claimed invention.

After reviewing the entire Notice, Applicant notes that the Examiner has not provided *any* evidence, whether it be reasoning or facts, that show the previously presented amended claims are actually “independent.” Rather, a closer reading of the Notice indicates that the Examiner believes these amended claims are drawn to a non-elected invention as being statutorily “distinct” from the previously pending claims. Nevertheless, for the amended claims to be “distinct” from the previously pending claims, the Examiner was required to provide evidence that substantiates *all three* of the prongs set forth in MPEP806.05(j), presented verbatim above. In lieu of providing such evidence, the Examiner observes, in a wholly conclusory manner, that “the currently presented claims have a different mode of operation”

from the previously pending claims, providing no specific examples of what characteristics are, in actuality, mutually exclusive. The parenthetical in the Notice which merely duplicates some of the amended claim language does not make all three of the MPEP proofs. Moreover, the fact that Applicant's amended claims include additional elements and limitations is not, in and of itself, sufficient to conclude that the claims are independent and distinct from the previously pending claims. Quite the contrary, standard patent practice is to amend the claims to obviate pending claim rejections. Notably, each of the amended independent claims includes *all* of the elements from the previously pending claims. Consequently, the pending Notice is improper under MPEP guidelines, and should therefore be withdrawn.

For at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the Notice of Non-complaint amendment.

**2. *There would not be a serious burden on the Examiner if restriction is not required.***

For the pending Notice to have been proper, the Examiner was required to show that, absent the restriction, there would be a serious burden on the Examiner. *See* MPEP 803(I). In order to establish "a serious burden," an examiner "must show by appropriate explanation" one of the following:

- (1) a separate classification – showing that each invention has attained recognition in the art as a separate subject for inventive effort or a separate field of search;
- (2) a separate status in the art - by citing patents which are evidence of such separate status, a separate field of search; or
- (3) a different field of search - it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s).

*See* MPEP 808.02. The Notice is devoid of any evidence establishing that search and examination of all amended claims in the subject application cannot be made without a serious burden to the Examiner. Moreover, section 803 of the MPEP clearly states that, "[i]f the search and examination of all the claims in an application can be made without serious burden, *the examiner must examine them on the merits*, even though they include claims to independent or distinct inventions." (emphasis added.) Thus, even if the Examiner were to maintain that the amended claims are directed towards independent and distinct inventions, there would be no serious burden on the Examiner to examine the amended claims. Accordingly, the pending Notice is improper under MPEP guidelines, and should therefore be withdrawn.

For at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the Notice of Non-complaint amendment.

### III. CONCLUSION

This submission is believed to be fully responsive to the Notice of Non-compliant Amendment of July 18, 2011 and the Office Action of January 14, 2011. The amendment and remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is herein respectfully requested. If the Examiner believes that a personal conference with Applicant's attorney will help expedite prosecution of the captioned application, the Examiner is reverently invited to contact the undersigned.

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All fees due in connection with this filing are believed to have already been paid. However, should any additional fees be deemed necessary, the Commissioner is hereby authorized to charge any inadvertently omitted fees (except for payment of the issue fee), to Nixon Peabody, LLC, Deposit Account No. 50-4181, Order No. 247079-000773USPT. Please credit any overcharges or overpayments to the same Deposit Account.

Respectfully submitted,

Date: August 3, 2011

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